THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD W. MORELAND

Appeal No. 1997-0174
Application No. 08/302,207[1]

ON BRIEF[2]

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 8, which are all of the claims pending in this application.[3]

[1] Application for patent filed September 8, 1994.

[2] On September 8, 1999, the appellant waived the oral hearing (see Paper No. 28) scheduled for September 16, 1999.

[3] Claims 4, 5 and 8 were amended subsequent to the final rejection.

We REVERSE.

BACKGROUND

The appellant's invention relates to rotary pulsing valves for whirlpool spas. An understanding of the invention can be derived from a reading of exemplary claims 1, 4 and 8 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Schirm	2,302,061	Nov. 17, 1942
Krumhansl	4,655,252	Apr. 7, 1987
Jones et al. (Jones)	4,989,641	Feb. 5, 1991

In addition, the examiner also relied upon the appellant's statement of admitted prior art (specification, page 1, line 7 to page 2, line 8) relating to a known spa massaging system (Admitted Prior Art).

Claim 8 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 3, 4, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Schirm and Jones.

Claims 5 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Schirm and Jones as applied to claim 4 above, and further in view of Krumhansl.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed July 24, 1996) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed June 10, 1996) for the appellant's arguments thereagainst.

OPINION

Initially we note that issue A (brief, pp. 4 and 5-6), whether the specification is properly objected to as failing to provide proper antecedent basis for claim 8, relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. In our view, this objection set forth on page 2 of the final rejection does not constitute a rejection of claim 8 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, we will not review this issue.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We will not sustain the rejection of claim 8 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the

language of the claim with a reasonable degree of certainty, a rejection of the claim under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of claim 8.

The examiner determined (answer, p. 4) that

> [t]he claim is unclear as to the limitation imparted by the language "sufficient torque" on line 6.

The appellant argues (brief, pp. 7-8) that the phrase "sufficient torque" included in the step of "rotating a selector, using the output of said turbine, with sufficient torque to overcome the presence of contaminants" is definite. The appellant submits that in this context, the phrase "sufficient torque to overcome" is similar to the phrase "an effective amount" which has been held to be definite where the amount was not critical and those skilled in the art would be able to determine from the written disclosure what an effective amount is.[4]

The examiner (answer, pp. 4-5) responded to the appellant's argument by stating that

> the "torque" limitation fails to particularly point out the exclusion to others sought by appellant, especially when such torque appears to be the heart of the invention as argued throughout the brief.

We agree with the appellant's position in this matter. In our opinion, the phrase "sufficient torque" is definite

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[4] The appellant cites to In re Halleck, 422 F.2d 911, 164 USPQ 647 (CCPA 1970) and Ex parte Skuballa, 12 USPQ2d 1570 (Bd. Pat. App. & Int. 1989).

since we believe the scope of the phrase as used in claim 8 can be determined from the language of the claim with a reasonable degree of certainty. In that regard, it is clear to us that in light of the teachings of the prior art and the appellant's disclosure[5] as it would be interpreted by one possessing the ordinary level of skill in the pertinent art, that the phrase "sufficient torque" as used in claim 8 means torque adequate to rotate the selector using the output of the turbine even in the presence of sand or other contaminants, thereby eliminating seizure of the selector. Thus, we view the limitation in question as merely relating to breadth of the claim, and accordingly conclude that rejection of the claim under

35 U.S.C. § 112, second paragraph, is inappropriate.

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[5] The specification (p. 6, lines 1-4) teaches that the "reduction in angular velocity of the output drive shaft 60 advantageously allows it to provide sufficient torque to rotate the selector even in the presence of sand or other contaminants, thereby eliminating the seizure problem present in prior-art devices."

For the reasons stated above, the decision of the examiner to reject claim 8 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness issues

We will not sustain the rejection of claims 1 and 3 through 8 under 35 U.S.C. § 103.

All the rejections under 35 U.S.C. § 103 in this appeal are founded on the examiner's determination (answer, p. 6) that

> in view of Schirm, it would have been obvious to one of ordinary skill in the art to associate a Geneva drive with the valve drive structure of the CYCLE-JET [the Admitted Prior Art] sequencing valve as such is a conventional valve drive structure for sequencing valves (pg. 1 col. 2 lns. 13-27) that provides positive indexing.

The appellant argues (brief, pp. 8-12) that the above-noted determination of obviousness by the examiner is improper. Specifically, the appellant asserts that the examiner has not provided any motivation, absent the use of impermissible hindsight, as to why one skilled in the art

would have modified the sequencing valve of the Admitted Prior Art to have included a Geneva drive. We agree.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18

USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

Thus, teachings of references can be combined only if there is some suggestion or incentive to do so. Here, the prior art contains none. In that regard, while Schirm does teach the use of a Geneva drive in a gas indicator apparatus, Schirm does not contain any teaching or suggestion to have modified the Admitted Prior Art to have used a Geneva drive as a gear reducer to increase the amount of torque provided by the turbine to the selector as set forth in various manners in the claims under appeal. Given the disparate nature of the Admitted Prior Art's CYCLE-JET system and Schirm, it appears to us that the examiner relied on impermissible hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in

the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

Since the examiner's determination of obviousness was incorrect for the reasons stated above, the decision of the examiner to reject claims 1 and 3 through 8 under 35 U.S.C. § 103 is reversed.[6]

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[6] We have also reviewed the references to Jones and Krumhansl but find nothing therein which makes up for the deficiencies of the Admitted Prior Art and Schirm discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claim 8 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 and 3 through 8 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

JAMES B. BEAR
KNOBBE, MARTENS, OLSON & BEAR
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660-8016

APPEAL NO. 1997-0174 - JUDGE NASE
APPLICATION NO. 08/302,207

APJ NASE

APJ FRANKFORT

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 13 Sep 99

FINAL TYPED: